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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,209	12/15/2000	Pieter J. van Zee	10003717-1	1143

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EXAMINER

MARIAM, DANIEL G

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/738,209

Applicant(s)

ZEE, PIETER J. VAN

Examiner

DANIEL G MARIAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 29, 2004 has been entered.

2. Applicant's arguments, see pages 8-9 of the remarks, filed May 27, 2004, with respect to the rejection(s) of claim(s) 1-34 under 35 U.S.C. 102 and 103 have been fully considered and are persuasive. Therefore, the Final rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Peairs (US Pat. No. 6,182,090) which will be discussed in the rejections below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peairs (6,182,090) in view of Zimmermann, et al. (6,678,694).

With regard to claim 1, Peairs discloses a method for efficient information storage and retrieval of information (See for example, col. 1, lines 12-15; and Fig. 1), comprising the steps of: capturing with a scanner (item 30, in Fig. 1) a selected portion of text of printed information wherein the selected portion of text captured is a close-to-unique identifier of the text, and serves

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as a key, i.e., key and/or identifier, when the information is accessed electronically (col. 4, lines 23-47), placing the key in an electronically available index to facilitate retrieval of the information (See for example, items 44 and 38, in Fig. 1); and (recommending topic matters) based on keys of previously scanned text of printed information and previously stored electronic information that are related to the printed information being captured during retrieval of the printed information (col. 5, lines 1-57; and item 50, in Fig. 1). While Peairs use a list of icons to represent the documents, Peairs does not explicitly call for recommending topic matters during retrieval. However, Zimmerman, et al (See for example, col. 10, Line 40 through col. 11, line 38) teaches this feature.

Peairs and Zimmerman, et al. are combinable because they are from the same field of endeavor, i.e., information/document retrieval (See for example, Fig. 1). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Zimmerman, et al. with Peairs. The motivation for doing so would at least allow narrowing down the search through dialogue and through the use of precise indexing, and to list the documents using topics, and to do so would at least improve the search and minimize the time taken during searching and retrieving. Therefore, it would have been obvious to combine Zimmerman, et al with Peairs to obtain the invention as specified in claim 1.

With regard to claim 2, the method of claim 1 wherein a portion of the information is in electronic form and the method further includes a step of storing the electronic information in a storage medium and making the electronic information available for search and retrieval using the key (See for example, Figure 1 of Peairs).

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With regard to claim 3, the method of claim 1 further including the steps of scanning and processing the information to provide an electronic copy of the information, storing the electronic copy of the information in a storage medium and making the electronic copy available for search and retrieval using the Key (See for example, Figure 1 of Peairs).

With regard to claim 4, the method of claim 1 wherein the information is stored in a non-commercially accessible database (See for example, Fig. 1 of Peairs).

With regard to claim 5, the method of claim 1 wherein the information is obtained from a commercially accessible database (which reads on col. 3, lines 28-30; and col. 5, lines 5-7 of Peairs).

With regard to claim 6, the method of claim 1 further including, upon the user requesting retrieval of information associated with the key, providing the information associated therewith (See for example, col. 5, lines 1-42 of Peairs).

With regard to claim 7, the method of claim 1 wherein the recommended topic matters include at least one of related uniform resource locators (URLs) to web pages, maps, books, and related articles (See for example, item 218 in Fig. 2; item 412, in Fig. 4; and col. 11, lines 12-38 of Zimmerman, et al). Therefore, it would have been obvious to one having ordinary skill in the art to incorporate the teaching as taught by Zimmerman, et al. into the system of Peairs, and to do so would at least provide a universal/global method for searching and accessing of information.

With regard to claim 8, the method of claim 1 further including clipping and holding the selected portion of text as a key for accessing information that is electronically available at a later date. Given the broadest reasonable interpretation, the key that is generated and stored in

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the document index table (See Fig. 1 of Peairs) is obviously used to enable a user/searcher to retrieve the electronically stored information at a later date.

Claims 9, 10, 11, 12, 13, 15 and 17 are rejected the same as claims 1, 2, 3, 4, 5, 6, and 8 respectively except claims 9, 10, 11, 12, 13, 15, and 17 are directed to system claims. Thus, arguments analogous to those presented above for claims 1, 2, 3, 4, 5, 6, and 8 are respectively applicable to claims 9, 10, 11, 12, 13, 15, and 17. Additionally, applicant's attention is invited to Figure 1 of Peairs.

With regard to claim 14, the system of claim 9 wherein the information is obtained from local accessible database (See Figure 1 of Peairs).

With regard to claim 16, the system of claim 9 wherein further related information is also provided that is correlated with at least one of: the key and associated information (See for example, col. 5, lines 9-42 of Peairs).

Claim 18 is rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is applicable to claim 18. Peairs further discloses a computer-readable medium having computer-executable instructions (See for example, Figure 1).

With regard to claim 19, the computer-readable medium of claim 18 wherein the information is in electronic form and the steps further include retrieving and indexing the information context identified by the index/directory for fast retrieval and processing (See Figure 1 of Peairs).

Claims 20, 21, 22, 23, 24, and 26 are rejected the same as claims 2, 3, 4, 5, 6, and 8 respectively. Thus, arguments analogous to those presented above for claims 2, 3, 4, 5, 6, and 8 are respectively applicable to claims 20, 21, 22, 23, 24, and 26.

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With regard to claim 25, the computer-readable medium of claim 18 wherein further related information is also provided that is correlated with at least one of: the key and associated information (See for example, col. 5, lines 9-42 of Peairs).

Claim 27 is rejected the same as claim 18. Thus, argument similar to that presented above for claim 18 is equally applicable to claim 27. Claim 27 distinguishes from claim 18 only in that it recites placing the key in an electronically available index on a web page accessible area to facilitate search and retrieval of desired incoming information. Zimmermann, et al. (See for example, Figures 4-5, & 11) teaches this feature.

Claims 28, 29, 30, 31, 32, and 34 are rejected the same as claims 20, 21, 22, 23, 24, and 26 respectively. Thus, arguments analogous to those presented above for claims 20, 21, 22, 23, 24, and 26 are respectively applicable to claims 28, 29, 30, 31, 32, and 34.

With regard to claim 33, the computer-readable medium of claim 27 wherein further related information is also provided that is correlated with at least one of: the key and associated information (See for example, col. 5, lines 9-42 of Peairs).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Number: 5,819,259.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL G MARIAM whose telephone number is 703-305-4010. The examiner can normally be reached on M-F (7:00-4:30) FIRST FRIDAY OFF.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LEO BOUDREAU can be reached on 703-305-4607. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DANIEL MIRIAM
PRIMARY EXAMINER

July 14, 2004